

**-- REMARKS --**

**A) Claims 2-4 and 17-19 were objected to**

The objections to claims 2-4 and 17-19 are traversed. First, Applicants note that this is the *sixth* office action and that two separate appeals have been reopened without appearing before the Board, without amending these claims, and that this is the first objection to these claims as informal. Second, there is no informality in claiming adding the modified call count. Third, Applicants have amended claims 2 and 17 to recite "summing" rather than adding. Applicants note that summing and adding are synonyms, and maintain their claim to any and all equivalents of the unamended claims, having solely made the amendment to more closely conform to the language used in the specification. With respect to the objections to claims 3 and 18, Applicant denies the existence of any informality, and note that the call count is determined based on time increments, as per the claimed elements of claim 1. Given that any potential informality has escaped the Examiner's notice through five previous rejections and two appeals, Applicants question the Examiner's alleged difficulty in understanding the claims. With respect to the objections to claims 4 and 19, Applicants thank the Examiner for noting the teachings of the specification, but further note that the specification speaks for itself. In addition, that the claim does not "say/show how a call count is rounded" does not make the claim informal, and that "a call count deems (sic) to be a whole number that does not require rounding" does not render the claim informal.

Withdrawal of the objections to claims 2-4 and 17-19 is requested.

**B) Claims 1, 2, 6, 16, 17, 21, and 31 were rejected under 35 U.S.C. §102(e) as anticipated by Lahtinen.**

The rejections to claims 1, 2, 6, 16, 17, 21, and 31 are traversed. In order for this §102(e) rejection to stand, each and every element of the claims must be disclosed in as great detail by the reference as claimed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

Cir. 1987). See also MPEP §2131.02 "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

At a minimum, Lahtinen does not disclose modifying the call count based on calling plan parameters as claimed in claims 1, 16, and 31. At most, Lahtinen discloses adding to a call counter. See, column 4, lines 3-17. No mention of calling plan parameters is included in the disclosures of Lahtinen.

In addition, Lahtinen does not disclose discounting an incoming call, as claimed in claims 6 and 21. At most, Lahtinen discloses adding call time, but not discounting any calls. See, column 4, lines 3-17.

Furthermore, claims 2, 6, 17, and 21 depend from independent claims 1 or 16 and are therefore allowable for at least the same reasons.

Withdrawal of the rejections to claims 1, 2, 6, 16, 17, 21, and 31 is requested.

**B) Claims 7-8, 22-23 and 32 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Toda.**

The rejection of claims 7-8, 22-23 and 32 as unpatentable over Lahtinen in view of Toda is traversed.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

With respect to claim 32, Lahtinen fails to teach or suggest modifying the call count based on calling plan parameters, as claimed. In addition, the Examiner does not rely on Toda for such a teaching, and therefore the §103(a) rejection fails on at least this ground. In addition, however, neither Lahtinen nor Toda discloses or teaches storing the modified call count in the memory of a cellular telephone unit, as claimed in claim 32. At most, Toda discloses a counter, but Toda does not disclose storing any data in the memory of a cellular telephone unit.

Next, as outlined above, Lahtinen does not disclose or teach discounting a call for any reason. Second, Toda does not disclose or teach discounting a call for any reason. Therefore, the references alone or in combination cannot teach or suggest discounting a nighttime call as claimed in claims 7 and 22 or discounting a weekend call as claimed in claims 8 and 23.

Furthermore, there can be no motivation to combine Lahtinen with Toda to store data in the memory of a cellular telephone unit, as claimed in claim 32. Lahtinen teaches that it is desirable to prevent mobile system overload while storing or updating location information relating to mobile stations in a VLR (col. 2, lines 11-14). Thus, Lahtinen is addressing problems at a base station that simply cannot be solved by storing data at the cellular phone level. In fact, storing such data at the cellular phone level would be harmful, according to Lahtinen, since the data could be lost if the phone is deactivated or leaves the service area. Therefore, combining the alleged teachings of Toda with Lahtinen would destroy the principle of operation of Lahtinen, in contravention of the strictures of §103(a).

Yet further, claims 7, 8, 22, and 23 depend from allowable claims 1 or 16 as outlined above, and are therefore allowable for at least the same reasons.

Withdrawal of the rejections to claims 7-8, 22-23, and 32 is requested.

**C) Claims 3 and 18 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Schwedes**

The rejection of claims 3 and 18 as unpatentable over Lahtinen in view of Schwedes is traversed. Claims 3 and 18 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Schwedes for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 3 and 18 is requested.

**D. Claims 4 and 19 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Abe**

The rejection of claims 4 and 19 as unpatentable over Lahtinen in view of Abe is traversed. Claims 4 and 19 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Abe for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 4 and 19 is requested.

**E. Claims 5 and 20 were rejected under 35 U.S.C. §103(a) under Lahtinen view of Kraushaar.**

The rejection of claims 5 and 20 as unpatentable over Lahtinen in view of Kraushaar is traversed. Claims 5 and 20 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Kraushaar for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 5 and 20 is requested.

**E. Claims 9-11 and 24-26 were rejected under 35 U.S.C. §103(a) under Lahtinen in view of Spitaletta.**

The rejection of claims 9-11 and 24-26 as unpatentable over Lahtinen in view of Spitaletta is traversed. Claims 9-11 and 24-26 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Spitaletta for at least the same

reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Claims 12, 13, 27 and 28 are dependent claims, depending from claims 1 and 16, and are therefore patentable over Lahtinen in view of Spitalletta for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 9-11 and 24-26, 12, 13, 27 and 28 is requested.

**F. Claims 14-15 and 29-30 were rejected under 35 U.S.C. §103(a) under “the above” in view of Brown**

The rejection of claims 14-15 and 29-30 as unpatentable over “the above” in view of Brown is traversed. First, Applicants are unable to determine a citation for a reference termed “the above.” No such patent or reference is previously listed in the rejections, and no such citation exists elsewhere in the file. In the event that the Examiner intended to reject over each of Lathinen, Spitalletta, Kraushaar, Abe, Toda, and Schwedes, or some subcombination, Applicants request that the Examiner make clear the basis for the rejection.

Regardless, however, claims 14-15 and 29-30 are dependent claims, depending from claims 1 and 16, and are therefore patentable over “the above” in view of Brown for at least the same reasons as claims 1 and 16 above. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to claims 14-15 and 29-30 is requested.

**SUMMARY**

Applicants believe that claims 1-31 fully comply with the requirements of 35 U.S.C. §§ 101, 102, 103 and 112, and that this case is ready for allowance. The rejections of claims 1-31 have been obviated by the above remarks. Withdrawal of all rejections is requested, and Applicants ask that this case pass to allowance without delay. If any questions remain that may be resolved in a telephonic interview, Applicants ask the Examiner to contact the undersigned.

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Respectfully submitted,

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